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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,314	08/31/2001	Martin W. Masters	2001P16282US	2179

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Siemens Corporation  
Intellectual Property Department  
186 Wood Avenue South  
Iselin, NJ 08830

EXAMINER

LAZOR, MICHELLE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/944,314

Applicant(s)

MASTERS ET AL.

Examiner

Michelle A Lazor

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1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08/31/2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10/9/03
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 8 are not clear as to which statutory class of invention the claim is directed. For the purposes of examination, a molding method is assumed.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 3, 6, 8 – 10, 13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoerkens (U.S. Patent No. 4803853).

Hoerkens discloses a method of fabricating a hearing instrument, comprising fabricating a shell comprising an outer surface comprising a series of layers (column 2, lines 35 – 41); and imparting a non-smooth texture to at least a portion of the outer surface of the shell by way of using a mesh screen, which comprises waveforms to the edges of one or more of the layers during the process of fabrication (Figures 1 – 6; column 1, lines 45 – 56). Thus Hoerkens

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discloses all the limitations of Claims 1 – 3, 6, 8 – 10, 13, and 16, and anticipates the claimed invention.

4. Claims 1, 2, 4, 8, 9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoest et al. (U.S. Patent No. 6097825).

Yoest et al. disclose a method of fabricating a hearing instrument, comprising fabricating a shell comprising an outer surface (Figure 4); and imparting a texture to at least a portion of the outer surface of the shell, which comprises imparting a non-reflective finish (column 1, line 65 – column 2, line 2). Thus Yoest et al. disclose all the limitations of Claims 1, 2, 4, 8, 9, and 11, and anticipate the claimed invention.

5. Claims 1 – 3, 5, 7 – 10, 12, and 14 – 17 are rejected under 35 U.S.C. 102(a) as being anticipated by Widmer et al. (U.S. Patent No. 6595317).

Widmer et al. disclose a method of fabricating a hearing instrument, comprising fabricating a shell comprising an outer surface that is fabricated from a mold cavity derived from surface contours of the user's ear and which comprises a series of layers; applying a laser to the surface (column 5, lines 4 – 29; column 6, lines 39 – 57); and imparting a non-smooth texture to at least a portion of the outer surface of the shell that includes a series of lines or ribs (Figures 18 – 20; column 13, lines 36 – 54). Thus Widmer et al. disclose all the limitations of Claims 1 – 3, 5, 7 – 10, 12, 14, 15, and 17, and anticipate the claimed invention.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widmer et al. as applied above in Claims 2 and 9, in view of Hoerkens.

Widmer et al. disclose all the limitations of Claims 2 and 9, but do not specifically disclose imparting a texture that comprises applying waveforms to the edges of one or more of the layers during the process of fabrication. However, Hoerkens discloses applying waveforms to the edges of one or more of the layers during the process of fabrication (Figures 1 – 6; column 1, lines 45 – 56). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to apply waveforms to the edges of one or more of the layers during the process of fabrication to permit the hearing aid to be worn inconspicuously (column 2, lines 42 – 51).

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Greenwood (U.S. Patent no. 2595672) discloses a hearing aid with a decorative cover (Figures 1 – 5), and Topholm et al. (U.S. Patent No. 5487012) disclose using a laser to cut cross-sections of the material used for the hearing aid (column 6, line 56 – column 7, line 8).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle A Lazor whose telephone number is 571-272-1232.

The examiner can normally be reached on Mon - Wed 6:30 - 4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



MAL  
1/22/04



**MICHAEL COLAIANNI**  
**PRIMARY EXAMINER**